



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

W

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,530	05/09/2001	Kurt Klimpel	15280-290110	7146

20350 7590 07/15/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

SCHWADRON, RONALD B

ART UNIT PAPER NUMBER

1644

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,530

Applicant(s)

KLIMPEL ET AL.

Examiner

Ron Schwadron, Ph.D.

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. Claims 1-6 are under consideration.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Leppla et al. (WO 94/18332). Applicants arguments have been considered and deemed not persuasive.

Leppla et al. teach anthrax protective antigen (see last paragraph page 25 and first paragraph, page 26) and a fusion protein containing the PA binding domain of LF/growth factor, wherein growth factors are full length proteins(see last paragraph page 25 and second paragraph, page 26). Leppla et al. teach that the fusion protein can contain the first 1-254 amino acids of LF (e.g. PA binding domain)(see pages 6 and 7). The name anthrax as used by Leppla et al. refers to *Bacillus anthracis* (see last paragraph page 3, continued on next page). Processed protective antigen is created when the anthrax protective antigen is administered in vivo. Leppla et al. teach that the LF/fusion protein and PA are administered as a pharmaceutical composition (see page 27) containing saline (aqueous solution of physiologically compatible salts, see page 28). Leppla et al. do not teach the molar ratio recited in claim 1. Leppla et al. teach that

Art Unit: 1644

the amount of PA and LF/fusion protein will be optimized using routine procedures. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have created the claimed invention because Leppla teach the claimed invention except for the molar ratio recited in claim 1 and Leppla et al. teach that the amount of PA and LF/fusion protein will be optimized using routine procedures. The recitation of an intended use in this product claim carries no patentable weight because the claimed product is the same as the product rendered obvious in the instant rejection. The dosage recited in the claims (as per defined in page 20, penultimate paragraph of the specification) is encompassed by the dose range disclosed in page 27, lines 24-25 of Leppla et al.

Regarding applicants comments that Leppala et al. do not teach the claimed conjugate containing full length protein, Leppla et al. teach anthrax protective antigen (see last paragraph page 25 and first paragraph, page 26) and a fusion protein containing the PA binding domain of LF/growth factor, wherein **growth factors and toxins are full length proteins**(see last paragraph page 25 and second paragraph, page 26). Regarding applicants comments about dosage, the specification discloses on page 20 that:

For each recipient, the total vaccine amount necessary can be deduced from protocols for immunization with other vaccines. The exact amount of such antigen- APABP and PA compositions required will vary from subject to subject, depending on the species, age, weight and general condition of the subject, the particular fusion protein used, its mode of administration, and the like. Generally, dosage will approximate that which is typical for the administration of other vaccines, and will preferably be in the range of about 10 ng/kg to 1 mg/kg.

Thus, regarding the functional dosage recited in the claims, said dosage will vary according to the antigen and particular parameters as per stated above. Said passage also discloses a general range of antigen to be used. Leppla et al., disclose administration of the instant invention at a dosage that overlaps that encompassed by the limitation now recited in the claims (see page 27, lines 24-25).

Art Unit: 1644

The recitation of an intended use carries no patentable weight in the instant product claims. Furthermore, the claimed composition as disclosed in Leppala et al. could induce a CTL response depending on the recipient and the protein used. For example, virtually any protein would be immunogenic/induce CTL if administered into another species (eg. the art recognizes that mouse Ig is immunogenic when administered to humans, etc). Regarding applicants comments about unexpected results, the MPEP section 2144.09, second column states:

"However, a claimed compound may be obvious because it was suggested by, or structurally similar to, a prior art compound even though a particular benefit of the claimed compound asserted by patentee is not expressly disclosed in the prior art. It is the differences in fact in their respective properties which are determinative of nonobviousness. If the prior art compound does in fact possess a particular benefit, even though the benefit is not recognized in the prior art, applicant's recognition of the benefit is not in itself sufficient to distinguish the claimed compound from the prior art. In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1991)."

The invention rendered obvious in the instant rejection has the same structure as the claimed invention and would therefore have the same properties as the claimed invention.


4. No claim is allowed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1644

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached Monday to Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at 571-2720841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800 *levo*

Ron Schwadron, Ph.D.

Primary Examiner

Art Unit 1644